

**Notice of Allowability**

Application No.

09/989,728

Examiner

Fozia M. Hamud

Applicant(s)

DESNOYERS ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to The amendment filed on 01/07/05 and petition filed on 01/25/05.
2. ☒ The allowed claim(s) is/are 119-126, 129-131, 135-138, (now renumbered 1-15, respectively).
3. ☒ The drawings filed on 21 November 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 01/07/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

  
JANET ANDRES  
PRIMARY EXAMINER

**REASONS FOR ALLOWANCE:**

1. Recipient of Applicants' arguments and amendment filed on 17 January 2005 is acknowledged. Claims 119-126, 129-130 and 137 have been amended. Claims 127-128 and 132-134 have been cancelled. Thus claims 119-126, 129-131 and 135-138 are pending and are in condition for allowance.

***Correction of Inventorship under 37 C.F.R. 51.48(b):***

2. Applicants' request for correction of inventorship under 37 C.F.R. 9 1.48 (b) filed on 25 January 2005, is granted.

***Priority:***

3. Applicants submit that they rely on the chondrocyte redifferentiation assay for patentable utility of this case, which was first disclosed in International Application PCT/US/00/08439, filed March 30, 2000, priority for which has been claimed in this application. Upon examining the PCT/US/00/08439, filed March 30, 2000, (WO200073454) it is found that this assay is disclosed in this application, (see SEQ ID NO:422, and page 531).

Therefore, the present application is afforded an effective filing date of March 30, 2000.

***Withdrawal of previous Rejections:***

4a. The rejection of claims 119-126, 129-131, 135-138 made under U.S.C. § 102 (b) as being anticipated by Ashkenazi et al (WO200032221; published 08 June 2000) is withdrawn, because the effective filing date (30 March 2000) of the current application predates the publication of this reference. Similarly, the rejection of claims 119-125,

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127, 129-131, 135-137, made under U.S.C. § 102 (b) as being anticipated by Walker et al (WO200029574; published 25 May 2000), is withdrawn, because the effective filing date of the current application (30 March 2000) predates the publication of this reference.

Therefore, 119-127 and 129-131, 135-138 are free of prior art of record.

4b. The rejection of claims 119-123 made under 35 U.S.C. 112, first paragraph, for not enabling the full scope of the claims and for lacking written description is withdrawn, because the claims recite both structural and functional limitations. Furthermore, one skilled in the art can make and use the claims.

4c. The rejection of claims 11-124, 128, 132 made under 35 U.S.C. 112, second paragraph, is withdrawn, because the amended claims no longer recite the vague limitations.

**Conclusion:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia M. Hamud whose telephone number is (571) 272-0884. The examiner can normally be reached on Monday, Thursday-Friday, 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda G. Brumback can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fozia Hamud  
Patent Examiner  
Art Unit 1647  
31 March 2005